

*Sub F3*  
-- Claim 103. (New) An isolated polynucleotide comprising nucleotides 211-468 of the  
fchd605 nucleotide sequence set forth in SEQ ID NO: 9.



Claim 104. (New) An isolated polynucleotide consisting of nucleotides 211-468 of  
the fchd605 nucleotide sequence set forth in SEQ ID NO: 9.

*Sub F3*  
Claim 105. (New) An isolated polynucleotide which hybridizes under highly stringent  
hybridization conditions to the polynucleotide of claim 104, wherein said highly stringent  
hybridization conditions comprise hybridization in 0.5 M NaHPO<sub>4</sub>, 7% sodium dodecyl sulfate  
(SDS), 1 mM EDTA at 65°C, and washing in 0.1xSSC/0.1% SDS at 68°C.

*Sub F3*  
Claim 106. (New) An isolated polynucleotide vector comprising peptide comprising  
the polynucleotide of claims 103, 104 or 105.

*Sub F3*  
Claim 107. (New) A host cell comprising the vector of claim 106.

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### Remarks

Claims 70, 71, 74, 77-89, and 97-102 are pending and under consideration in the above-identified application. Claims 70, 71, 74, 77-89, and 97-102 have been canceled without prejudice, and Applicant reserves the right to pursue the subject matter of these claims in additional applications.

New Claims 103-107 have been added to more particularly point out and distinctly claim that which Applicant regards as the invention. Support for new Claims 103-107 can be found

in the specification as originally filed. In particular, support for new Claims 103, 104, 106 and 107 can be found in Figure 5, SEQ ID NO: 9, in the specification at page 118, lines 1-9, and in the specification at page 44, lines 6-14. Support for new Claim 105 can be found in the specification at page 37, lines 31-34. Accordingly, Applicant respectfully submits therefore that new Claims 103-107 do not introduce new matter.

The instant application claims the benefit of priority under 35 U.S.C. § 119(e) from the U.S. Provisional Patent Application No. 60/011,787, filed February 16, 1996.

Applicant respectfully submits that, in view of the fact that the formal requirements of 35 U.S.C. § 119(e) have been met and, as explained below, the disclosure of the instant application provides the written description support required under 35 U.S.C. § 112, first paragraph for pending claims 103-107.

In particular, Applicant respectfully submits that more than adequate written description support for the presently claimed invention can be found, *inter alia*, in the specification of the instant application at page 118, lines 1-9, wherein it states:

The fchd605 gene produced a 1.5kb mRNA that is up-regulated after 5 hours treatment with oxidized LDL, and to a lesser degree with native LDL, as compared to untreated monocytes. The amplified DNA was sequenced and used to recover a cDNA of approximately 2.2kb, which was sequenced to reveal a partial open reading frame of approximately 258 bp, encoding approximately 86 amino acids. The DNA sequence and encoded amino acid sequence from the fchd605 gene is shown in FIG.5. The sequence has similarity to the mouse gly96 gene, which encodes a cytokine inducible glycosylated protein expressed in mouse lung, testes, and uterus.

Applicant respectfully submits that one of ordinary skill in the art would understand that the 258 bp sequence referred to above is from the 3' end of the fchd605 open reading frame as shown in Figure 5. In particular, the specification at page 23, lines 4-19, describes how the claimed cDNA was produced, as follows:

The reverse oligonucleotide primer of the primer pairs may contain an oligo dT stretch of nucleotides, preferably eleven nucleotides long, at its 5' end, which hybridizes to the poly(A) tail of mRNA or to the complement of a cDNA reverse transcribed from an mRNA poly(A) tail. Second, in order to increase the specificity of the reverse primer, the primer may contain one or more, preferably two, additional nucleotides at its 3' end. Because, statistically, only a subset of the mRNA derived sequences present in the sample of interest will hybridize to such primers, the additional nucleotides allow the primers to amplify only a subset of the mRNA derived sequences present in the sample of interest. This is preferred in that it allows more accurate and complete visualization and characterization of each of the bands representing amplified sequences.

Thus, it is this 258 bp 3'-end-specific region of the fchd605 open reading frame, depicted from nucleotides 211-468 within the nucleotide sequence shown in Figure 5 of the instant application, which is described in the passage at page 18, lines 1-9 quoted above.

Therefore, the specification demonstrates that Applicant was indeed in possession of the isolated polynucleotide comprising nucleotides 211-468 of Figure 5 and SEQ ID NO: 9 at the time the instant application was filed, thereby fulfilling the written description requirement under 35 U.S.C. § 112, first paragraph. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991). Indeed, the fact that Applicant was in possession of the subject matter of Claims 103-107 is further demonstrated by the disclosure of the priority Application No. 60/011,787. The precise language of the text of page 118, lines 1-9 of the instant application is contained in the priority application at page 108, line 28-page 109, line 2. Moreover, Figure 5 of the priority application, which is referred to in this passage, depicts precisely nucleotides 211-468 of SEQ ID NO:9 of the instant application.

Clearly, the nucleotide sequence specified in the claims from nucleotides 211-468, that is depicted in Figure 5 of the instant application, was not only described and in the possession of the Applicant at the filing date of the instant application, but was described and in the possession of the Applicant at the filing date of the prior provisional Application No. 60/011,787,

February 16, 1996. Thus, the instant application adequately described the claimed polynucleotides such that the skilled person would realize that the Applicant was in possession of the claimed subject matter. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991).

Furthermore, the instant application claims the benefit of priority to provisional Application No. 60/011,787, filed on February 16, 1996 under 35 U.S.C. § 119(e). Thus, Applicant respectfully submits that the Kondratyev *et al.* (Cancer Res, 56, 1489-1502, April 1, 1996) publication cited by the Examiner in U.S. Application No. 08/799,910 does not qualify as prior art under 35 U.S.C. § 102(a) against pending claims 103-107.

### ***Conclusion***

Applicant respectfully requests that the above amendments and remarks be made of record in the instant application.

Respectfully submitted,

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